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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,515	08/19/2003	John Russell	11306-116002	4506
26191	7590	06/14/2006	EXAMINER	
FISH & RICHARDSON P.C.			FAISON GEE, VERONICA FAYE	
PO BOX 1022			ART UNIT	PAPER NUMBER
MINNEAPOLIS, MN 55440-1022			1755	

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/643,515

Applicant(s)

RUSSELL ET AL.

Examiner

Veronica Faison-Gee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,38-51 and 54-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,38-46 and 57-60 is/are allowed.
- 6) ☒ Claim(s) 47,48 and 51 is/are rejected.
- 7) ☒ Claim(s) 49 and 50 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

Claims 1 and 39 have been amended and claims 52 and 53 have been canceled. Hence, claims 1, 2, 38-51 and 54-60 are pending in the application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 47, 48 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2 397 276 in view of Hoy (US Patent 6,063,412) and in further view of Osada et al (US Patent 5,070,230).

GB 2 397 276 is described above, but fails to teach lithographic printing.

Hoy teaches an edible greeting card for ingestion (abstract). The reference further teaches that an edible ink wherein the colorant was a nontoxic coloring agent. The ink composition may be printed with a variety of printing techniques that included silk screening, lithography, laser imprinting and embossing (col. 4 lines 55-65). The reference fails to teach the viscosity of the composition.

Osada et al teach the viscosity of a screen printable composition is within the range of 1,000 to 20,000 centipoise (col. 4 lines 42-45).

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Therefore it would have been obvious to one of ordinary skill in the art that the ink viscosity of GB 2 397 276 would be in Applicant's claimed range, because Osada et al teaches that the viscosity of screen printable compositions are within the range that overlaps Applicant's claimed range

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have replaced screen printing with lithographic printing because the substitution of art recognized equivalents as shown by Hoy would have been within the level of ordinary skill in the art.

***Allowable Subject Matter***

Claims 1, 2, 38-46 and 57-60 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

1. The Examiner is relying upon Applicant's arguments for the patentability of the instant claims, specifically Applicant's argument that Ahn teaches viscosity of the liquefied sugar component should be 50-90 Brix, however the 90 Brix solution has a viscosity of less than about 20 cp using the test method described in the application, even when the 90 Brix sugar solution was combined with maximum suggested concentration of TiO<sub>2</sub>, the viscosity of the ink base was only about 500 cp was found persuasive and therefore the rejection of the claims has been withdrawn.
2. an edible ink composition comprising a pigment density of about 0.1 g/l to about 0.25 g/l and an ink density of about 1.1 g/l to about 2.0 g/l.

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Claims 49 and 50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The references alone or in combination fail to teach an edible ink composition with the specific composition set forth in claims 49 and 50 in view of the rest of the claim limitation of the independent claims.

### ***Response to Arguments***

Applicant's arguments filed 4-10-06 have been fully considered but they are not persuasive.

Applicants respectfully note the GB 2 397 276 reference, which shares several inventors in common with the present Application, is not prior art under any section of 35 USC 102. According, all obviousness rejection relying upon the GB 2 397 276 reference are improper.

The Examiner disagrees, the burden of establishing that subject matter is disqualified as prior art is placed on applicant once the examiner has established a prima facie case of obviousness based on the subject matter. \*>For example, the< fact that the reference and the application have the same assignee is not, by itself, sufficient evidence to disqualify the prior art under 35 U.S.C. 103(c). There must be a statement that the common ownership was "at the time the invention was made." Applicant has

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not satisfied all of the requirements to disqualify GB 2 397 276 as a reference and therefore the rejection has been maintained.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Veronica Faison-Gee whose telephone number is 571-272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

vfg  
6-12-06

  
J. A. BORENGO  
SUPERVISORY PATENT EXAMINER